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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/708,125

02/09/2004

Mark Joseph Stanley

2124

39802

7590

09/14/2007

MARK STANLEY
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EXAMINER

DUFFY, DAVID W

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

09/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/708,125

Applicant(s)

STANLEY, MARK JOSEPH

Examiner

David W. Duffy

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/09/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02/09/2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 02/09/2004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1-25 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-25 of copending Application No. 10/774715. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Drawings

3. Figure 3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

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4. The disclosure is objected to because of the following informalities:

- a. Para. 27 "... related t the ..." is missing an o.
- b. Para. 34 "... the in-game characters direction ..." should be possessive.
- c. Para. 39 "... of jerky on- ff in-game ..." is missing an o.

Appropriate correction is required.

5. Claims 17 and 22 are objected to because of the following informalities:

- a. Claim 17 "... pointing device are selected..." should be "is selected".
- b. Claim 17 "...said c mputer pointing..." is missing an o.
- c. Claim 22 "...pointing device to its right..." should be "...device is moved to its right..."
- d. Claim 22 "...its reward directi n;" is missing an o.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 23, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Roger "Wildcat" Morris (Mad Catz Panther XL).

8. In regards to claim 23, Morris discloses a video game controller that has a joystick to control motion and a trackball to control the direction of sight in a three dimensional game and is compatible with a computer.

9. In regards to claim 24 and 25, the game controller is a single device that produces command data that a video game would perceive as readily as a game pad style controller as video games do not differentiate between physical structures of controllers and only respond to the commands generated.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-4, 8-11, 15 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson (US 6488584) in view of Mr. Coates (Sega Dreamcast Mouse – Review – Why should you buy this?).

12. In regards to claims 1, 2, 8, 9 and 15, Nelson discloses an apparatus with a keyboard receptacle, a keyboard code to game code converter and a video game controller plug (figure 4, 3:44-51 and 3:61-4:2) in order to provide keyboard use for a game console. Nelson seems to lack in disclosing the inclusion of a mouse receptacle and corresponding conversion of mouse inputs.

13. In related prior art, Mr. Coates discloses that it is advantageous to have a mouse and keyboard for playing games on a game console. One skilled in the art would recognize the advantages of providing keyboard and mouse support to game customers, as those are common input devices.

14. Therefore it would have been obvious to one skilled in the art at the time to modify the keyboard adapter of Nelson to further include a mouse connection to provide the complete control setup preferred by PC owners.

15. In regards to claims 3, 4, 10, 11, 20 and 21, Nelson discloses the system of claim 1 above and further discloses mapping keys to joystick position to replicate the joystick on the keyboard (4:46-61). Nelson seems to lack in disclosing the inclusion of a mouse receptacle and corresponding conversion of mouse inputs.

16. In related prior art, Mr. Coates teaches the use of computer mice with keyboards for game consoles to replace the game pad controller. One skilled in the art would recognize the advantage of providing a preferred controller setup for a consumer device where the keyboard and mouse replace the game pad controller.

17. Therefore it would have been obvious to one skilled in the art at the time to use a mouse with a keyboard as a game input where the mouse is used as the joystick input as it is a similar pointing device. As such, it would be obvious to translate the mouse position information to joystick codes to be properly recognized by the game console.

18. In regards to claim 19, Nelson discloses mapping keyboard codes to game controller codes (2:13-21).

19. Claims 5-7, 12-14 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Mr. Coates and further in view of Morris (Mad Catz Panther XL).

20. In regards to claims 5, 6, 12, 13, 16 and 17, Nelson in view of Mr. Coates discloses the system as set forth for claims 1, 2, 8, 9 and 15 above. The combination

made seems to lack in disclosing the use of a second mouse to simulate additional joysticks on a game pad.

21. In related prior art, Morris discloses a game controller with dual pointing devices (the trackball and the joystick) to control action in a game. One skilled in the art would recognize the advantages of providing two pointing devices in a controller in order to control the full three dimensional movement of a game character and to replicate the dual joysticks of gaming systems.

22. Therefore it would have been obvious to one skilled in the art at the time to combine the teachings of Morris with the combination made for claim 1 in order to fully replicate the dual joystick controller of gaming systems.

23. In regards to claims 7 and 14, Nelson discloses the system of claims 1 and 8 above and further discloses mapping keys to joystick position to replicate the joystick on the keyboard (4:46-61). Nelson seems to lack in disclosing the use of a mouse in addition to the keyboard.

24. In related prior art, Mr. Coates teaches the use of computer mice with keyboards for game consoles to replace the game pad controller. One skilled in the art would recognize the advantage of providing a preferred controller setup for a consumer device where the keyboard and mouse replace the game pad controller.

25. Therefore it would have been obvious to one skilled in the art at the time to use a mouse with a keyboard as a game input with the mouse used as the joystick input as it is a similar pointing device. As such, it would be obvious to translate the mouse position information to joystick codes to be properly recognized by the game console.

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26. In regards to claim 18, Nelson discloses mapping keyboard codes to game controller codes (2:13-21).

27. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Mr. Coates as applied to claim 15 above, and further in view of Chapweske (The PS/2 Mouse Interface) and official notice.

28. In regards to claim 22, the combination made for claim 15 made above seems to lack explicitly stating the accumulation of movement values from a pointing device to approximate a game pad thumb stick.

29. In related prior art, Chapweske discloses that the PS/2 mouse accumulates movement and outputs the change in position of the mouse at a set interval. One skilled in the art would recognize the advantages of tracking movement for an input device.

30. Therefore it would have been obvious to one skilled in the art at the time to use the teachings of movement tracking with the input system of the combination of Nelson and Mr. Coates.

31. The combination made seems to lack explicitly disclosing mapping the values to game pad controller thumb stick. However, examiner takes OFFICIAL NOTICE that it is notoriously well known in the art of video games to use a mouse interchangeably with a joystick, which is functionally identical to a thumb stick of a game pad type controller.

Conclusion

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Niedzwiecki US 5896125 directed to game controller adapters.

Sanderson et al. US 6071194 directed to configurable game controllers. Chu et al. US 6615299 directed to control code translation. Tanaka et al. US 7098777 directed to a game controller communications system. And Perala US 5917472 directed to dual mice configuration.

Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as

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well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David W. Duffy whose telephone number is (571) 272-1574. The examiner can normally be reached on M-F 0830-1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DWD



/Corbett Coburn/
Primary Examiner
AU 3714